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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,892	05/07/2007	Vittorio Pasolini	J1036.0019/P019	4093
24998	7590	09/28/2010	EXAMINER	
DICKSTEIN SHAPIRO LLP			HONG, JOHN C	
1825 EYE STREET NW			ART UNIT	
Washington, DC 20006-5403			PAPER NUMBER	
			3726	
			MAIL DATE	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,892	<b>Applicant(s)</b> PASOLINI, VITTORIO	
	<b>Examiner</b> JOHN C. HONG	<b>Art Unit</b> 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/10/06</u> . | 6) <input type="checkbox"/> Other: ____.  |

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### DETAILED ACTION

1. Applicant is reminded of the proper language and format for an **abstract** of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "**means**" and "**said**," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- 1) Claim 1, line 1, "the electrical connection" lacks antecedent basis.
- 2) Claim 1, line 2, "railway track or the like" is indefinite.
- 3) Claim 1, line 5, "the removable connection" lacks antecedent basis.
- 4) Claim 1, line 8, "the strike head" lacks antecedent basis.
- 5) Claim 1, line 10, "means making" is indefinite.
- 6) Claim 6, line 2, "said rotatably/ and/or translatably integral connection" lacks antecedent basis.
- 7) Claim 10, lines 1 and 2, "the tightening" lacks antecedent basis.

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- 8) Claim 13, line 3, “interdos” is not understood.
- 9) Claim 18, lines 2 and 3, “the material” lacks antecedent basis.
- 10) Claim 20, line 2, “preferably” is indefinite.
- 11) Claim 21, line 1, “the electrical connection” lacks antecedent basis.
- 12) Claim 21, lines 2, “or the like” is indefinite.
- 13) Claim 21, line 2, “the removable connection” lacks antecedent basis.
- 14) Claim 21, line 6, “means making” is indefinite.
- 15) Claim 22, line 11, “the point” lacks antecedent basis.
- 16) Claim 22, line 14, “the material” lacks antecedent basis.
- 17) Claim 24, line 5, “shavings” is using the numeral (10) which is used for “projecting parts”.
- 18) Claim 25, line 3, “preferably” is indefinite.
- 19) Claim 26, line 1, “the run-out” lacks antecedent basis.
- 20) Claim 26, lines 2 and 3, “the elimination” lacks antecedent basis.
- 21) Claim 26, line 3, “the distance” lacks antecedent basis.
- 22) Claim 26, line 4, “the incision tips” lacks antecedent basis.
- 23) Claim 27, line 17, “the movement” lacks antecedent basis.
- 24) Claim 27, line 19, “the material” lacks antecedent basis.
- 25) Claim 33, line 2, “the cavities” lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-16 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Markey (U.S. Patent 3476010).

Markey discloses :Regarding Claim(s) 1-16 and 18-20, screw (Fig.1) for the electrical connection of a cable terminal to a railway track or the like, comprising a base body (1) having: - an elongated shank having a longitudinal axis (L), - a strike head (3) connected with a first end of the shank - means (2) for the removable connection of a strike organ or nut with a second end of the shank ) opposite said first end, said screw further comprising: - a support element (7) manufactured separately from the base body (1) and associated to the strike head (3) so as to form a stroke that defines a cavity turned towards the second end of the shank , wherein the screw is pre-assembled and comprises means (9) making a substantially irreversible connection of the support element to the base body (Fig. 1- 3); and Regarding Claim(s) 21, a nut(12) is pre-assembled and comprises means making a substantially irreversible connection of the support element to the strike organ (Fig. 2).

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

6. Claims 22,24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Markey (U.S. Patent 3476010).

Markey discloses : Method for manufacturing a screw according to any of claims I to 20 claim 1, comprising the following steps: providing a base body having: - an elongated shank having a longitudinal axis , - a strike head connected with a first end of the shank , - means for

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the removable connection of a strike organ or nut with a second end of the shank opposite said first end, to provide a support element manufactured separately from the base body and provided with a cavity and an aperture suitable to house the shank ; inserting the shank of the base body into the aperture of the support element to the point in which the support element abuts against the strike head so as to form a stroke that defines a cavity turned towards the second end of the shank, comprising further the step of: deforming the material of the shank in order to form one or more projecting parts (10) that make a substantially irreversible connection of the support element to the base body (Figs 1-3).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Markey (U.S. Patent 3476010).

Markey teach the limitation except the projecting parts are three projecting parts.

But this is a matter of design choice and Markey's projection has the same effect in operation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN C. HONG whose telephone number is 571-272-4529. The examiner can normally be reached on M-F 9:00-17:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID BRYANT can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOHN C HONG/  
Primary Examiner, Art Unit 3726

jh